

## REMARKS

The present amendment is submitted in response to the Office Action dated August 19, 2008, which set a three-month period for response, making this amendment due by November 19, 2008.

Claims 1-20 are pending in this application.

In the Office Action, the specification was objected to for an informality. Claim 10 was objected to for being indefinite. Claims 1, 2, 6, 7, and 11 were rejected under 35 U.S.C. 102(b) as being anticipated by GB 2397704 A to Mather et al. Claims 1, 3, 4, 5, and 7 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,571,949 to Burrus, IV et al. Claims 8-10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Burrus, IV et al in view of U.S. Patent No. 6,066,938 to Hyodo et al.

In the present amendment, the specification was amended to add a cross reference to the related priority document to address the objection. In addition, standard headings were added and references to the claims were deleted.

Although claim 10 was objected to, the Applicant believes the Examiner intended the objection to relate to claim 9, which has been amended herein.

Turning next to the substantive rejections of the claims, claim 1 has been amended to more clearly define the invention over the cited references by adding the feature that *said power tool is stored in a transport position in said first receiving area, and wherein said power tool is arranged in a second receiving area during said charging procedure in a standing position*. Support for this new

language can be found on page 1, paragraph [0020] and page 2, paragraph [0021] of the publication application and Figs. 1-3.

In addition, new claims 12-20 have been added. Support for new claim 12 can be found in Fig. 1. Support for new claim 13 is disclosed on page 2, paragraph [0022] and shown in Figs. 1, 3, and 4. The features of new claims 14 and 15 are found on page 2, paragraph [0021] and in Fig. 3. The features of new claim 16 can be found on page 1, paragraph [0006] and in Figs. 1-4 in reference numeral 18. Features of new claim 17 are disclosed on page 1, paragraph [0009] and are shown in Figs. 1-4. New claim 18 is supported by the disclosure on page 1, paragraph [0009] and on page 2, paragraph [0025] and Figs. 1-4. New claim 19 is supported by the disclosure on page 2, paragraph [0025] and Figs. 1-3, while support for new claim 20 can be found on page 2, paragraph [0023] and in Fig. 3.

The cited reference to Mather discloses a case (1) for a battery powered tool with a charging panel (2) for recharging batteries and which is supplied as an integrated part of the case (1) (see Mather, Fig. 1 and page 2).

In contrast, the present application claims a device with a power tool case (10), that includes at least one first receiving area (12) for a power tool (16), and a charger (14), wherein the charger (14) and the power tool (16) are designed to remain connected during a charging procedure and wherein said power tool (16) is stored in its transport position in said first receiving area (12) and *wherein said power tool (16) is arranged in a second receiving area (26) during said charging procedure in a standing position.*

The Mather reference discloses *no second receiving area in which a power tool is arranged during a charging procedure* in a standing position.

Therefore, amended claim 1 is not anticipated by the Mather reference.

The patent to Burrus discloses a toolbox (100), which is fastened to a bed of a vehicle. The toolbox (100) can be used to recharge a power tool (104) arranged in a compartment (101) of the toolbox via an electrical connector (105) electrically connected to the automotive electrical system when the vehicle is running (see Burrus, Figs. 1, 2 and 4 as well as column 2, lines 6 to 9 and lines 25 to 27 as well as lines 40 to 56).

In contrast, the present application claims a device with a power tool case (10), that includes at least one first receiving area (12) for a power tool (16), and a charger (14), wherein the charger (14) and the power tool (16) are designed to remain connected during a charging procedure and wherein said power tool (16) is stored in its transport position in said first receiving area (12) and *wherein said power tool (16) is arranged in a second receiving area (26) during said charging procedure in a standing position.*

The Burrus reference discloses *no second receiving area in which a power tool is arranged during a charging procedure in a standing position.* Thus, amended claim 1 also is not anticipated by the reference to Burrus.

The claims also are not rendered obvious by either reference, whether viewed alone or in combination. Mather teaches providing a case (1) with a storage area for a power tool in the event of transportation and storage,

respectively. Moreover, a charger panel (2) for recharging batteries is provided (see Mather, Fig. 1 and page 1, lines 1 to 3).

In contrast, the present invention provides a power tool case (10) with two receiving areas (12, 26) for a power tool (16). In the first receiving area (12), the power tool (16) is stored during a transport of the power tool case (10) or the power tool (16), respectively. *The second receiving area (26), however, is provided to arrange the power tool (16) during a charging procedure and specifically in a standing position of the power tool (16).* Due to this arrangement, it can be easily detected by an operator or even by any bypassing person, whether the power tool (16) is being charged (standing position) or is stored for the purpose of transportation (lying position). If the power tool (16) is located in the first receiving area (12), the tool (16) is stored for transportation. However, if the power tool (16) is arranged in the second receiving area (26), indicated by the standing position of the power tool (16), the power tool (16) and a charger (14) are in the recharging mode. Therefore, a construction or arrangement can be provided which is very operator friendly and which can indicate its actual condition with less effort.

In the Mather reference, no second receiving area for a power tool is provided and especially no receiving area by which a charging state of the power tool case (1) is indicated by a standing position of the power tool. Moreover, no motivation is given in the disclosure of the Mather reference which would have led someone skilled in the art at the time the invention was made to the inventive idea of the present invention to provide a second

receiving area for the power tool in the charging state. In addition, no suggestion is provided to arrange the power tool in a receiving area in a standing position.

Accordingly, amended claim 1 is not rendered obvious by the Mather reference.

The Burrus reference teaches arranging a power tool (104) in a lying position in a compartment (101), which is located in a toolbox (100) electrically connected to an automotive electrical system when the vehicle is running (see Burrus, Figs. 1, 2 and 4 as well as column 2, lines 25 to 27 as well as lines 40 to 56).

Burrus does not teach arranging the power tool (104) during the charging procedure in a standing position of the power tool (104). Further, the reference to Burrus provides the practitioner skilled in the art with no motivation to arrange the power tool (104) during the recharge process in a standing position, especially because it is specifically shown in Fig. 2 that the compartment (104) is provided with an intake with a matching contour of the power tool (104) and thus, that the power tool is recharged in a lying position. Thus, the invention as recited in the amended claim 1 is not rendered obvious over Burrus.

In addition, the combination of Mather and Burrus would not lead the practitioner skilled in the art to the subject matter of amended claim 1. Neither Mather nor Burrus discloses a receiving area for a power tool wherein the power tool is arranged during the recharge process in a standing position.

Likewise, this feature would not be obtained by a combination of either Mather or Burrus with the Hyodo et al. reference. Thus, new claim 1 is also patentable over any arbitrary combination of the cited references.

It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01. When establishing obviousness under Section 103, it is not pertinent whether the prior art device possess the functional characteristics of the claimed invention, if the reference does not describe or suggest its structure. *In re Mills*, 16 USPQ 2d 1430, 1432-33 (Fed. Cir. 1990).

The application in its amended state is believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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